

Remarks/Arguments

Oath/Declaration

The requirement for a new Oath is not understood. Applicants' have enclosed their copy of the Oath and the Letter of Notice to File Corrected Patent Application papers it received from the Patent Office. As can be seen in Applicants' copies, all inventors had signed the Oath and the Notice to File Corrected application showed no requirement for a new Oath because of a failure of an inventor to sign. Clarification is requested.

Claim Objections

The claims 1 and 8 have been amended as suggested by the Examiner.

Claims Rejections under 35 USC 112

The claims have been amended in light of the Examiner's objections under this section. For instance in claim 1:

- a) The "merchants products" have been changed to -- products of the on-line merchant--
- b) The "number of hits to product descriptions" have been changed to -- a count of hits to product descriptions--
- c) The "merchants marketing strategy" has been changed to --a marketing strategy of the merchant--

d) The recitation of “providing a presentation of products to the customer” has been changed to --providing to the shopper a presentation of products--.

As amended, claim 1 contains a proper antecedent for SWF in dependent claims.

In claim 6, the highest ranked has been changed to -- a highest ranked--.

In claim 7, “the method of claim 6 transmitting” has been changed to --the method of claim 6 including transmitting--.

The changes in claim 8 mirror the changes made in claim 1.

Double Patenting

The applicants’ attorney does not agree with the Examiner that the claims in application #10/120,082 are not patentably distinguish from each other. The claims in that case clearly distinguish patentably over the claims here in that they call for reranking of the product rankings obtained off the internet prior to modifying the rankings to reflect a marketing strategy of the rerankers. No such reranking is recited in the claims of this case. However to eliminate the question of double patenting from prosecution of this application, applicants’ herewith are submitting a copy of a Terminal Disclaimer relative to the claims of any patent issuing on application #10/120,082.

Claim Rejections under 35 USC 103

Claims 1 to 3 and 5 to 10 have been rejected under 35 USC 103(a) as being unpatentable over Spiegel et al. 6466918 in view of Nabe et al 2002/0049701A1.

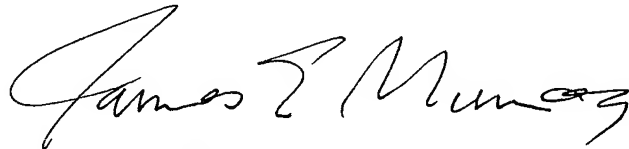
The present application discloses a method, software and apparatus which enable a merchant to promote products and services in a deterministic manner. When a shopper enters a set of key words in an entry in an on-screen form for a web server to obtain a list of items (products and/or services) of interest to the shopper, the documents describing the items are prioritized based on the web sites owner's organizational strategic decisions by the merchant providing a weighting factor for the products and services. The weighting factor is combined with existing ranking mechanisms to the documents to increase the probability that certain items come to the top when the search results are presented to the shopper. These items could be used to ensure shoppers do not overlook special offers or to reduce overstocks by promoting products with a large inventory. The weighting factor is configured so as to not decrease the shoppers confidence in the ranking process.

The Examiner does not allege that either reference discloses having a factor based on merchant's marketing strategy to modify ranking of merchant's products in an on-line response to a user's request. Further, there is no discussion in the Nabe reference of the subject matter contained in the Spiegel patent. In addition, the Examiner did not reject claims 4 and 11 based on the cited combination.

As amended the claims that distinguish from the prior art combination for the reasons given above. Independent claims 1 and 8 have been amended to include subject matter found in claims 4 and 11. Claim 1 has been amended by adding the subject matter of claims 2, 3 and 4 while claim 8 has been amended by the addition of the subject matter contained in claim 11. New independent claim 12 covers an internet server and contains the subject matter recited in claim 11. For this reason, claims 1, 8 and 12, and all claims depending therefrom, are allowable over the prior art.

For the above reasons, it is respectfully submitted that all claims are allowable, and therefore it is requested that the application be reconsidered, allowed and passed to issue.

RESPECTFULLY SUBMITTED,

A handwritten signature in black ink, appearing to read "James E. Murray". The signature is fluid and cursive, with the first name "James" and last name "Murray" clearly distinguishable.

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